

REMARKS

Retained claim 1, as an example, (earlier copied from Cotte et al U.S. Patent No. 5,499,108 for purposes of interference) uses the specific words "responsive to" and "in response to" placement of the document into the scanner, which the present Examiner has interpreted as meaning something different from the description in applicants' specification of the operation of their system--therefore rejecting the claims (and others depending therefrom) under 35 U.S.C. 112, first paragraph.

Applicants are unable to find these specific words "in response to" and "responsive to" as claimed, either defined in or even used in the Cotte patent specification. If, however, the substance of what is actually disclosed in the Cotte patent responds to these specific claim words, then they apply in exactly the same way to, the applicants' disclosure.

If the conventional dictionary definition of these words is used, moreover, they similarly identically read upon the disclosures of the Cotte patent and applicants' disclosure (i.e. "react to"; "act in answer to something"--p.711, Roget's 21st Thesaurus, for example).

It is in order, therefore, to review what the operation of the Cotte patent (where the claims originated) actually involves, because that is what these words must be interpreted as meaning.

The Cotte et al Patent Structure Compared With Applicants' Structure

The following demonstrates that Cotte et al and applicants have made the same invention and for the same purpose.

Cotte et al

- (1) In summarizing the operation of their patent, Cotte et al use a "paper *input device*" that "senses the insertion of a document to be scanned (and) initiates a host computer process...scans the images and text on the paper...while sending the scanned data to the host for further electronic processing such as *display, transmission, storage* or modification" (col. 2, lines 41 on).
- (2) The "user can put the document in the paper input device and the input device software will automatically scan the document" (col. 16, l. 7).
- (3) The broad novelty of "this new technology is a paper input device using scanning technology which controls the host computer rather than *the other way around*, the latter being what is taught in the *prior art*" (col. 2, l. 50).
- (4) Among the important applications are for "FAX" (col. 13, l. 28) and "photocopy" function (col. 19, l. 39). An objective is to aid untrained people to operate: "simplifies the life of the user...and is decoupled from the need to *know how* to invoke the appropriate software" (col. 14, l. 40).

Applicants

- (1) Applicants also use the "scanners"...as *input devices*, (col. 7, l. 49), [referring more conveniently to applicants' patent 5,623,295 which has the identical disclosure of the application], wherein "the user inserts the paper into the paper feeding slot. A sensor detects the document, scans it and sends the data back to the computer" (col. 7, l. 54). In the "master mode", the scanner sensor "*automatically* starts scanning, initiates communications protocol with the host computer and the host receives the scanned data" (col. 6, l. 30).
- (2) "The user starts the scanning process...*simply by* inserting a document into the scanner feeding slot 14 (master mode)", (col. 6, l. 17).
- (3) In the "master mode", the "keyboard-scanner is the master device and the computer is used (transparently to the user) as a slave output device" (col. 8, l. 12), instead of "the *regular* way a scanner keyboard and other auxiliary I/O devices work with the computer [i.e. prior art].
- (4) Among the important "predefined functions" is "for *fax* machine operation" (col. 8, l. 25, on) and "*copying* machines" (col. 6, l. 51; col. 8, l. 35). "The master mode of operation, moreover, enables *untrained people* easily to operate the computer as familiar "FAX or COPY machines." (col. 8, l. 40). This is done "transparently to the user" (col. 8, l. 12), "where a user is not

familiar with computers" or *lacks "know how* to operate the computer and its software applications" (col. 7, l. 60).

Cotte et al

The "paper input device...senses the insertion of a document to be scanned, *initiates a host computer process...*" There is then "the sending (of) the scanned data to the host for...*display*" or for "*storage*" (col. 2, l. 47) in accordance with the "computer process."

Applicants

"The user inserts a document into the scanner input slot...and starts a communication protocol with the host computer."

There is then "communication with the host computer" of "the document scanned data" (col. 6, l. 7). This is in accordance with this "protocol", wherein "the host receives the scanned data...where it is *stored* for application to retrieve it" (col. 6, l. 33), or "may also use the computer to *display*" the scanned data (col. 8, l. 32). See, also, col. 8, l. 30, "the computer is used as a slave output device for *display communication*".

Corroborating the above as to what applicants' description means to one skilled in the art, applicants refer to the testimony of the earlier submitted Declaration of Ralph Rodriguez of January 23, 2004:

"10. Treating with the first alleged lack of description (i.e. that the specification does not teach that "the placement alone is sufficient to initiate said drawing" of the document through the scanner, the Examiner, with respect, is absolutely in error!

This is *exactly* what one skilled in this art understands to be described in column 6, lines 16-19;

" The user starts the scanning process... simply by inserting a document into the scanner feeding slot 14 (master mode)."

More than just initiating the feeding and scanning of the document through the scanner, this act of "inserting the document into the scanner," also automatically "initiates communications protocol with the host computer" (column 6, line 31,), which is then "used as a slave output device for display communication and printing" (column 8, lines 2-5 -- incidentally describing *two* distinct user-selectable options)."

Cotte et al

To effectuate "*display*" of the scanned image data, Cotte et al, in several embodiments, sends the scanned data to be "buffered in RAM memory...until such time as data path...is not busy"; and then such is retrieved from such storage and sent "to the host computer...for further processing or to the FAX modem" (col. 9, l. 1-10).

As again explained at col. 10, line 1, in Cotte et al, after "the document is scanned", the "data is *buffered* either before or after being compressed...for *later transmission* to the host computer or the FAX modem."

Applicants

Applicants describe, also, that "*simply by inserting* a document into the scanner feeding slot" (col. 6, l. 17), the "scanner automatically starts scanning, *initiates* communications protocol with the host computer and the host receives the scanned data...where it is *stored* for application to retrieve it" (col. 8, l. 32), as for "use (of) the computer display to *display* " (col. 8, l. 33).

Whereas Cotte et al, as above quoted, may first store the scanned image data in a "buffer", applicants may first store in a " 'spool' directory" (col. 6, l. 33).

This brings us to the last "means" of claim 1. Claim 1 (unlike claim 2), however, does not address or require the displaying of the scanned image data itself.

Claim 1 recites only the displaying of

"a plurality of user-selectable options for processing said image data";
but with the requirement that such displaying be "*in response to said placement*"--again, however, with no use or definition of that term in the specification.

Cotte et al Display of Options

In Fig. 17 and in column 10, starting at line 44, however, Cotte et al do define what they mean by the claimed phrase "user-selectable options for processing said image data". These are "menu options...such as 'FAX this image'...'send this image...for printing", etc.

Applicants Display the Same Options

These very *same options* for processing the scanned image data, among others, are also taught in applicants' specification and drawings: "SEND FAX" (col. 8, l. 25); "prints it on the printer, FIGS. 7C, 7D, 7G" (col. 8, l. 40). Applicants describe the "options" as "preferred functions" (col. 8, l. 25).

Applicants further positively teach that such options for processing the scanned image data may also be *displayed*:

"may also use the computer display to display...transmitted fax status information and *operation instructions*, Figs. 7C, 7D, 7E, 7F," (col. 8, l. 33).

[See, for example, in "MASTER OPERATION MODE of Fig. 7C-7E of the drawings; "HOST 'DISPLAY STATUS', 'FAX FUNCTION', 'COPY FUNCTION', etc)].

That the "communications protocol" with the computer was initiated "*solely*" by the placement of the document in applicants' scanner has been demonstrated above.

Cotte et al uses the words "*commands*" (col. 14, l. 31; col. 15, l. 28 and 61, on; col. 18, l. 66; col. 21, l. 22) and "*protocol transmission*" (col. 15, l. 1; col. 17, l. 21) to describe the

well-known protocol that is also identically described by applicants and in the very same words: "*command*" (col. 6, l. 17, 23) and "*communications protocol*" (col. 6, l. 31; col. 8, l. 21, 31, 37). Neither Cotte et al nor applicants go into detail on these "protocols" since they were so well-known at the time and inherent in the pertinent host computers.

The only remaining limitations of claim 1 (which the Examiner stresses by underlining) is that such "protocols" for enabling host computer display of options must be initiated "in response to said placement". Both Cotte et al and applicants disclose doing this initiation in precisely the same manner "in response to" the insertion of the document, as earlier discussed:

Cotte et al

"senses the insertion of a document to be scanned, initiates a host computer process"...by insertion of the paper...scans the images and text on the paper...while sending the scanned data to the host for further electronic processing such as display...storage" (col. 2, l. 42, on).

Applicants

"the user inserts the paper into the paper feeding slot. A sensor detects the document" (col. 7, l. 54) and "automatically starts scanning, initiates communications protocol with the host computer and the host receives the scanned data" (col. 6, l. 30).

"simply inserting a document into the scanner feeding slot 14 (master mode)", (col. 6, l. 17).

Summary

The above is believed unambiguously to show the substantial identity of the Cotte et al disclosure and operation and that of applicants. Claim 1 (and the other claims) if read to mean and describe what Cotte et al discloses, must also be read in precisely the same way on applicants' disclosure.

In further support of the above, the expert testimony provided in said Declaration of Ralph Rodriguez states

"11...As one skilled in this art, reading the application and including the reference to "menu" in column 7, line 52 and knowing that, as before stated, in the port connection of all scanners to "IBM PC" computers in that era (column 6, lines 7-10), protocol universally involved initially and automatically displaying the menu on the computer screen upon hook-up to the scanner, I must strongly state that the specification thus positively provides such a teaching, and that such display of the menu on the screen was also inherent for all scanner-computer connection protocol." (Underlining added)."

"The application teaches, moreover, that precisely this same menu display protocol was then the conventional operation with all scanners, also (column 7, line 51, on; also column 4, lines 20-27)."

The Rodriguez Declaration continues:

"This only leaves the matter of whether this "displaying" is of "a plurality of user-selectable options"....

"With the insertion or placement of the document in the scanner in the "Master Mode", (col. 8, line 3, on) initiating the display communication protocol, including "SEND TO HOST ' DISPLAY STATUS' COMMAND" (Fig. 7C, before discussed), this causes the displaying of the universal protocol options menu, always provided in the 1992 era by scanner-computer interfacing."

"This, to one skilled in the art including me, is also explained in paragraph 9 above, and clearly means the display by the computer monitor of "a plurality of user-selectable options for processing said image data "of claim 1 -- and it certainly is taught in the application, as initiated in the application by placement alone of the document into the scanner." [Underling added]

18. The objectives and basic implementation of applicants and of Cotte et al are the same; and claim 1, above-discussed, certainly applies equally to their respective disclosures and in the same way."

The Office Invitation To Provide Evidence of Well-Known Features in the Art

Though applicants have above shown that the applicants' disclosure clearly teaches

"means for displaying, in response to said placement, a plurality of user-solicitable options for processing said image",

the Office has invited the submission of evidence as to what "features are well-known in the art."

Even had applicants not specifically taught the displaying of a plurality of user-selectable options (which the Office on page 5, lines 7 and 8, of its action now appears correctly to concede that they did describe, as above shown), the feature of automatic

display in personal and other host computers of "user-selectable options" were indeed well-known and inherent at the time of both the Cotte et al and applicants' applications.

The patent to Cotte et al so admits:

"software *commonly found* on user's computers" (col. 11, l. 47)

"the details of the *prior art* image compression algorithms are incorporated by reference as if set out fully herein" (col. 14, l. 59).

"user...selections from a menu of options which automatically appears" (col. 15, l. 30).

"A *typical* pop-up window of user menu options" (col. 15, l. 51).

Applicants' specification also so concedes:

"The electronic circuit board 12, 13...circuits, in *well-known* fashion, control all keyboard and scanner operations" (col. 5, l. 37).

"IBM PC" (col. 1, l. 47); with a personal computer...with a PC or any other host, using the office or external network..." (col. 6, l. 50).

"The user may choose to use a scanner for data input by picking scan operation from a menu... This is the *regular way* a scanner keyboard and other auxiliary I/O devices work with a computer" (col. 7, l. 56).

"the operations *found on any* fax or copy machine" (col. 8, l. 26).

In further support of the above, the expert testimony provided in said

Declaration of Ralph Rodriguez states:

"The application teaches, moreover, that precisely this same menu display protocol was then the conventional operation with all scanners, also (column 7, line 51, on; also column 4, lines 20-27)."

Earlier, Mr. Rodriguez explained that:

"8. Long before the filing of the above application, hundreds of thousands of scanners interfaced or communicated with host computers all over the world, -- and for...well-known protocols for... a menu of user-selectable options or functions indicated on the display. Everyone skilled in this art knows (and certainly knew at the time of the filing of the above application) that this is how scanners in 1992 *always* communicated with computer displays -- every one of the scanner modules identified at the top of column 2 (lines 1-6), and every one of their protocols with the "IBM PC" host computer of the era (column 1, line 43)."

What was not known, however, before the applicants' invention and the Cotte et al disclosure, was the initiation of such display of user-selectable options "in response to said placement" of the document in the scanner.

The Office appears now to agree that there was no lack of disclosure in applicants' application of

"just simply displaying a plurality of user-selectable options" (page 5, lines 7 and 8 of Office action).

The Office contends, rather, that the applicants did not disclose such displaying

"in response to said placement"

of the document into the scanner input device.

This has earlier been shown, however, to be in error. As summarized by Mr. Rodriguez in his Declaration:

"19. In summary, therefore, it is the placement of the document into the scanner slot of applicants' scanner that alone initiates the scanning, and alone starts the communication protocol, including display for user-selection of options.

This is also made extremely clear in connection with the description of the options of "fax/copy":

"When operating in "master mode" ...when the user inserts a document into the document feeding slot 14, a sensor 4, 4a, senses the document and converts the operation of the device...where the keyboard-scanner is the master device and the computer is used (transparently to the user) as a slave output."
(Column 8, line 5, on).

"The user inserts a document into the scanner input slot 14. The inserted document moves the mechanical arm 4A of the document sensor 4. The sensor sets flag "MASTER" ON...and starts a communication protocol with the host computer...It may also use the computer display to display...status information, and operation instructions, FIGS 7C, 7D, 7E, 7F." (Column 8, line 33, on).

And earlier, for just document scanning and the options of image display and storage:

" The user starts the scanning process...simply by inserting a document into the scanner feeding slot 14 (master mode)...the scanner automatically starts scanning, initiates communications protocol with the host computer and the host receives the scanned data into a 'spool' directory where it is stored for application to retrieve it..." (Col. 6).

The running display of scanned image data and storage are, of course, and were in 1992, the standard computer-scanner protocol, inherent in all such systems.

To one skilled in the art, including me, this unambiguously teaches the specific limitations of claim 1:

"wherein said placement alone is sufficient to initiate said drawing, and said computer comprising means for displaying, in response to said placement, a plurality of user-selectable options for processing said image data".

Applicants' disclosure clearly meets the terms of the claims, which are accordingly allowable to them

In order to complete the record herein of prior art known features, moreover, as to the meaning in the era of applicants' application of the phrase "the host receives the scanned data into a 'spool' directory" (col. 6, l. 33), applicants submit herewith the Declaration of Dov Aharanson.

The Further Impropriety Of This Belated § 112 Rejection

If the previous Examiner had held the present Examiner's 112 views, there would have been no need to have suspended Ex Parte prosecution until determination of the re-examination of the Cotte et al patent from which applicants copied the present claims for purpose of interference--only to reject the claims as not supported by the disclosure.

Clearly, in continuing all these years and in entering the suspension, the view of the previous Examiner was that an interference was appropriate.

Never, in response to applicants' status requests, or oral and written communications with the first Examiner, over a *six-year period*, did the first Examiner ever raise any issue, 112 or otherwise, of the adequacy of applicants' specification disclosure to support a single one of these claims--only the continuing promise of the declaration of an interference "soon".

As earlier pointed out--and the present Examiner has *not* answered this--MPEP-Sec. 2307.04. --specifically restricts the use of such a suspension to cases "*otherwise in condition for allowance*".

The first Examiner thus clearly issued the suspension under this understanding of allowability to applicants; and applicants had no objection, being also anxious to determine the validity of the claims under re-examination.

As also earlier pointed out--and again the present Examiner has *not* answered this--MPEP- Sec. 2307.04. --specifically restricts the use of such a suspension to cases "*otherwise in condition for allowance*".

As also earlier pointed out--and again the present Examiner has *not* answered this--the MPEP instructs the Examiner to continue the prosecution "as far as possible", being specifically *mandated* by MPEP Sec. 707.07/ g to "*reject each claim on all valid grounds available*".

The first Examiner had no such grounds (certainly not § 112) and never asserted any.

As also earlier pointed out--and again the present Examiner has *not* answered this--the MPEP Sec. 704 --requires "*full faith and credit...be given to...the action of a previous examiner...(and) an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner...*"

Withdrawal of this improper and greatly belated § 112 rejection, and the prompt declaration of an interference are therefore respectfully requested--particularly, in light of the technical incorrectness of the new § 112 rejection, above shown.

Any costs incurred by this amendment, including for the RCE filing costs and for any required time extensions, petition for which is hereby made, may be charged to Deposit Account No. 18-1425 of the undersigned attorneys.

Respectfully submitted,

RINES AND RINES

By: 

Robert H. Rines

Registration No. 15,932

Customer No. 41840

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RINES AND RINES

24 Warren Street

Concord, NH 03301

Tel: (603) 228-0121